

REMARKS

At the time of the Final Office Action dated May 6, 2005, claims 1-10 were pending and rejected in this application.

CLAIMS 1-2, 5-7, AND 10 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON UPTON ET AL., U.S. PATENT PUBLICATION NO. 2003/0105884 (HEREINAFTER UPTON), IN VIEW OF JEFFRIES ET AL., U.S. PATENT NO. 6,094,529 (HEREINAFTER JEFFRIES), AND FURTHER IN VIEW OF HOMER ET AL., "INSTANT HTML," COPYRIGHT 1997, PAGES 88-101 (HEREINAFTER HOMER)

On December 16, 2004, Applicants have submitted a Declaration by Radhika Aggarwal, William H. Krebs, Elizabeth A. Schreiber, and David Styles, the sole inventors of the present invention to which this patent application applies, swearing behind Upton and establishing an invention date which precedes that of Upton. Since the Upton reference is not prior art to the present claimed invention, the rejection of claims 1-2, 5-7, and 10 under 35 U.S.C. § 103 cannot stand. Accordingly, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1-2, 5-7, and 10 under 35 U.S.C. § 103 for obviousness based upon Upton in view of Jeffries and Homer.

In the Final Office Action, the Examiner asserts that the Declaration submitted December 16, 2004, is insufficient. Applicants respectfully disagree with the Examiner's assessment of the Declaration for reasons stated below.

**CLAIMS 3-4 AND 8-9 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED
UPON UPTON IN VIEW OF JEFFRIES AND HOMER AND FURTHER IN VIEW OF HARTMANN, U.S.
PATENT NO. 6,615,226**

Since the Upton reference is not prior art to the present claimed invention, the rejection of claims 3-4 and 8-9 under 35 U.S.C. § 103(a) cannot stand. Accordingly, Applicants respectfully solicit withdrawal of the imposed rejection of claims 3-4 and 8-9 under 35 U.S.C. § 103 for obviousness based upon Upton in view of Jeffries, Homer, and Hartmann

DECLARATION FILED DECEMBER 16, 2004

On page 7 of the Final Office Action, the Examiner asserted that the declaration was insufficient in showing the facts that the claimed invention was conceived by Applicants. Applicants respectfully disagree since the Declaration referred to a disclosure document, entitled "RSW8-2000-0307," which was attached to the Declaration and provides clear factual support for the assertions made by Applicants in the Declaration.

Notwithstanding Applicants' assertion that the Declaration meets the requirements described in M.P.E.P. § 715.07, Applicants submit the following additional explanation with regard to the assertions made by Applicants in the Declaration and the factual support provided by the disclosure document.

As noted in paragraph (2.) on page 2 of the Declaration, the inventive method includes the following steps:

- a) detecting in a form-based submit, at least one validation error based upon a value provided through an input-element in a markup specified form;
- b) inserting a row in the markup specified form in a position which is proximate to the input-element, said row having a background color which differs from other colors which are visible in proximity to the inserted row;
- c) selecting error text corresponding to the validation error and inserting the selected error text in the row;
- d) further inserting an anchor tag in the markup specified form in a position which is proximate to the input-element; and,
- e) serving the markup specified form in a response to the form-based submit,
- f) the response referencing the anchor tag.

Step a) describes the detection of a validation error. As noted in the paragraph spanning pages 2 and 3 of Applicants' disclosure, the detection of a validation error in a form-based submit is well known, and the detection of a validation error is described throughout the disclosure document.

Step b) includes two portions:

- b1) inserting a row in the markup specified form in a position which is proximate to the input-element,
- b2) said row having a background color which differs from other colors which are visible in proximity to the inserted row

With regard to step b1), reference is made to page 2 of the disclosure document, which states "[w]e decided to place the error message right under the invalid object" and "we would reload the page and add an extra row underneath the object."

With regard to step b2), reference is made to page 2 of the disclosure document, which states:

To achieve that effect the row, that was added in order to hold the error message, was given a background color. Normally, the text the surrounding an object on the page as a background color of white. By giving the error message a different

background it made the message text look visually different from the regular text on the page.

With regard to step c), reference is made to page 2 of the disclosure document, which states "[t]his new row would contain the error message." Examples of different kinds of error messages, depending upon the type of error, are found on the last three lines on page 2 of the disclosure document and include: "The data entered is not a number;" "The data entered is too small;" and "The data entered is too big."

With regard to step d), reference is made to page 3 of the disclosure document, which states:

Thus, we used the concept of jumping to a spot on the page by using the anchor tag and "#" in the URL. If an object was marked invalid we would add an anchor, whose name matched the word in the URL following "#", at the beginning of the object. By placing it at the beginning of the object, ensured that both the object and the error message would be visible, since error message is beneath the object.

Steps e) and f) describe the well-known mechanism of serving a markup specified form in a response and the response referring to the anchor tag. On page 3 of the disclosure document, reference is made to "the page to reload with the invalid object in the range of the window," and immediately following that line is the aforementioned disclosure of how this is accomplished using the anchor tag.

Applicants, therefore, respectfully submit that the disclosure document provides factual support, as described in M.P.E.P. § 715.07, for the assertions made by Applicants in the Declaration that the present patent application claims an invention that was conceived by Applicants prior to October 2001.

ACTUAL REDUCTION TO PRACTICE AND CONSTRUCTIVE REDUCTION TO PRACTICE

In the Final Office Action, the Examiner also questioned the diligence from prior to October 18, 2001 (the filing date of Upton et al.) until Applicants constructive reduction to practice date of January 3, 2002 (the filing date of the present application). Referred to by the Examiner on page 7 of the Final Office Action, M.P.E.P. § 715.07 discusses "Three Ways to Show Prior Invention." The Examiner's comments are with regard to showing (C), which is constructive reduction to practice. Applicants, however, submit that showing (A) has also been established by the Declaration.

As stated on paragraph (4.) on page 2 of the Declaration, "[a]t the time of submitting the Disclosure an experimental prototype of the Invention had been created and work had begun in producing a production version of the Invention." Thus, actual reduction to practice had been achieved by Applicants. As noted in M.P.E.P. § 715.07, "[i]n general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, 'there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice.'" Applicants respectfully submit that the experimental prototype of the Invention described in the Declaration constitutes an actual reduction to practice that meets the requirements of showing (A) referred to above.

Notwithstanding Applicants' assertion that showing (A) has been established, Applicants also submit that the requirements of showing (C) have also been met. As discussed in M.P.E.P. § 715.07(a) and noted by the Examiner on page 8 of the Final Office Action, due diligence is required from just prior to the reference date to the filing date of the application. The reference

date of Upton is October 18, 2001, and on October 29, 2001, Applicants reviewed a final draft of the application, and on November 8, 2001, Applicants executed the "Declaration and Power of Attorney for Patent Application" for the present application. Given the closeness of these dates, Applicants submit that due diligence was exercised between just prior to the reference date of Upton and the execution of the "Declaration and Power of Attorney for Patent Application."

As noted in M.P.E.P. § 2138.06, "[r]easonable diligence is all that is required of the attorney" and "[i]f the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient." As is readily apparent from the dates, there are three major holidays (i.e., Thanksgiving, Christmas, and New Years) between November 8, 2001 (the date that the Declaration and Power of Attorney for Patent Application was executed by Applicants) and January 3, 2002 (the filing date of the present application). Applicants also note that International Business Machines Corporation, the assignee of the present application, is consistently the largest filer of patent applications with the USPTO.¹ Given the unmatched number of applications filed each year by IBM and the number of major holidays that occurred between the aforementioned dates, Applicants respectfully submit that the period of time between the execution date of the Declaration and Power of Attorney for Patent Application and the filing date of the present application is not unreasonable, and thus, IBM's attorneys exercised reasonable diligence in filing the present patent application. Therefore, Applicants submit that the requirements of showing (C) have also been met.

¹ See, USPTO TODAY, Volume 3, No. 1, January 2002 (In a preliminary list, IBM ranked #1 with 3,411 patent issued in 2001); In a preliminary list, IBM ranked #1 with 3,288 patents issued in 2002 <http://www.uspto.gov/web/offices/com/speeches/03-01.htm>.

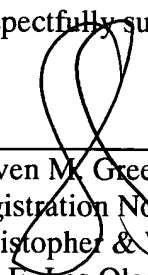
For the reasons stated above, Applicants respectfully submit that the Declaration filed on December 16, 2004, is sufficient to establish an invention date which precedes that of Upton.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,



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